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FEB 10 2011

OFFICE OF PETITIONS

In re Application of :
PHILIP CHIDI NJEMANZE :
Application No. 10/770606 :
Filing or 371(c) Date: 02/03/2004 : ON PETITION
Title of Invention: :
TRANSCRANIAL DOPPLER :
SPECTROSCOPY FOR ASSESSMENT :
OF BRAIN COGNITIVE FUNCTIONS :

This is a decision on the petition to revive an application for patent abandoned unavoidably under 37 CFR 1.137(a), filed November 9, 2010.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed October 2, 2006. The Office action set a three (3) month period for reply from the mail date of the Office action. Extensions of time were available under 37 CFR 1.136(a).

Applicant filed a reply/amendment on October 31, 2006; however, the amendment was not entered because the amended claims were not properly marked with status identifiers, and the replacement drawings were not marked "amended." Applicant was so notified in a Notice of Non-Compliant Amendment mailed to Applicant on November 31, 2006.

Applicant filed a second response to the Office action on December 11, 2006, which also was not entered because claims 1-20 were missing, and the claims were not provided with proper status

identifiers. Applicant was so notified in a second Notice of Non-Compliant Amendment mailed on December 19, 2006.

Applicant filed a third reply on February 8, 2007, which was again not entered because the reply at that time required an extension of time fee to have been considered timely. The Examiner also notes in the Notice of Abandonment mailed May 6, 2009, that the reply filed February 8, 2007 would also have been non-compliant as the amended portions of the claims did not contain the proper underlining/strikethrough to show which parts were amended.

The Examiner notes that a fee deficiency mailed to Applicant on July 23, 2007, was mailed in error.

No complete and proper reply to the non-final Office action, mailed October 2, 2006, having been received, the application became abandoned on January 3, 2006. A Notice of Abandonment was mailed on May 6, 2009, detailing the above noted sequence of events.

The present petition

Applicant files the present petition and states that the reason for the delay in filing a complete and proper reply to the Office action, mailed October 2, 2006, was because the reply he filed on February 3, 2007 was received after the expiration of the response period. Applicant avers that the delay in mail getting to him was due to the December Holiday period during which time there were political election registration holidays in Nigeria with major mail backlogs. Applicant asserts that the factors of receiving mail on time during peak holiday period, disrupted by political issues were beyond his control and he was not made aware of the abandonment until he checked the status on the internet. Petitioner notes that the last communication he received from this Office was a letter communicating a fee requirement of \$60.00, mailed on July 23, 2007, which Applicant responded to by check.

A Grantable Petition Under 37 CFR 1.137(a)

A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Applicant lacks items (1) and (3) as set forth above.

As to item (1), Applicant has filed a reply to the Office action on February 8, 2007; however, as noted in the Notice of Abandonment by the Examiner, the reply/amendment is again non-

compliant as the amended portions of the claims did not contain the proper underlining/strikethrough to show which parts were amended.

As to item (3), Applicant must provide a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Applicable Law, Rules and MPEP

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath , 38 App. D.C. 497, 514-15 (1912)(quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute “unavoidable” delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not “unavoidable” when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. Likewise, as a “reasonably prudent person” would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant’s failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute “unavoidable” delay. See Krahn, 15 USPQ2d at 1825. Finally, a delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered

"unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985). 35 U.S.C. 133 and 151 each require a showing that the "delay" was "unavoidable," which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990).

The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. Id. at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, Applicant is advised that when he chooses to prosecute without the assistance of counsel, he is obligated to either familiarize himself with the requirements of successfully prosecuting this application, or retain counsel. Persons seeking patent rights have no "right" to the assistance of counsel during the application process. Boyden v. Commissioner of Patents, 441 F.2d 1041, 168 USPQ 680 (D.C. Cir. 1971).

Analysis

Initially applicant is advised that the application became abandoned because applicant failed to file a complete and proper reply to the non-final Office action mailed October 2, 2006. The applicable Rule, 37 CFR § 1.135, Abandonment for failure to reply within time period, states

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. (Emphasis added).

Here, Applicant filed a reply to the Office action on October 31, 2006; and on December 11, 2006. Both times the replies were not entered because the amendments were non-compliant. Applicant had failed to file a complete and proper reply to the Office action. Thereafter, Applicant filed a reply to the Office action on February 8, 2007; however, the reply was due on or before January 2, 2007. The reply filed February 8, 2007 required an extension of time to have been considered timely. Moreover, the reply was again not a complete and proper reply as noted by the Examiner. It is reiterated that the application became abandoned for failing to file a complete and proper reply to the Office action mailed October 2, 2006.

As to unavoidable delay, Applicant is advised that, as stated above, the lack of knowledge or improper application of the patent laws and rules do not constitute unavoidable delay. Likewise, the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action, also does not constitute unavoidable delay. When an Applicant chooses to prosecute without the assistance of counsel, he is obligated to either familiarize himself with the requirements of successfully prosecuting this application, or retain counsel. Persons seeking patent rights have no "right" to the assistance of counsel during the application process.

Conclusion

Applicant has failed to file a complete and proper reply to the Office action, and failed to demonstrate that the failure to file a complete and proper reply to the Office action was unavoidable. The petition is dismissed.

Applicant is advised that a list of registered practitioners is available at www.uspto.gov/main/patents. Applicant is further advised that the Inventor's Assistance Center is available, at 1-800-786-9199, for assistance in prosecuting the patent application.

A refund of the \$60.00 extension of time fee may be requested by writing to the Office of Finance, Refund Section Director for Patents, PO Box 1450, Alexandria, VA 22313-1450. Alternatively, Applicant may wish to file a petition based upon an unintentional abandonment of the application as discussed below, and request this Office apply the \$60.00 to the fee for the petition to revive the application based upon unintentional abandonment.

Alternate venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently \$770.00 for a small entity.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the

date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

In order for the petition under 37 CFR 1.137(b) to be considered a grantable petition, the petition, the petition fee, and a complete and proper reply to the Office action mailed October 2, 2006, are required.

Applicant is advised that a list of registered practitioners is available at www.uspto.gov/main/patents. Applicant is further advised that the Inventor's Assistance Center is available to provide assistance, at 1-800-786-9199, for assistance in prosecuting the patent application.

A copy of the Manual of Patent Examining Procedure can be found at <http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
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By FAX: (571) 273-8300
Attn: Office of Petitions

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Telephone inquiries concerning this Decision only should be directed to the undersigned at (571) 272-3232.

/DLW/

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